

REMARKS

The Office action mailed on 2 May 2005 (Paper No. 20050418) has been carefully considered.

Claims 1, 3 thru 7, 9 and 11 thru 14 are being amended, and claims 15 and 16 are being added. Thus, claims 1, 3 thru 7, 9 and 11 thru 16 are pending in the application.

In paragraph 6 of the Office action, the Examiner rejected claims 1 and 9 under 35 U.S.C. §112 (second paragraph) as failing to set forth the subject matter which applicant regards as his invention. Specifically, the Examiner questions whether the Applicant is claiming that a phone number is inputted only when an error is detected, or whether the Applicant is claiming the input of a phone number regardless of whether or not an error has occurred or is going to occur.

In response, as indicated in Figure 3 of the application (specifically, step S301 thereof), Applicant is claiming that an input telephone number of a second facsimile machine for receiving data when an error occurs is inputted by the user initially prior to receiving data from a transmitting facsimile machine. Thus, page 10, lines 14-17 of the application, when read together with the disclosure of Figure 3, indicates that the Applicant is claiming input of a telephone number of a second facsimile machine prior to reception of the data, so that the second facsimile machine can be used to receive the

faxed data when faxed data cannot be received by the first receiving facsimile machine due to error occurrence. In this regard, in order to make the intention of the Applicant totally clear, claims 1 and 9 are being amended to insert the words “to be used” prior to the words “when an error occurs” (in claim 1, lines 5-6) and prior to the words “when the errors occur” (in claim 9, line 3). As a result, the rejection under 35 U.S.C. §112 (second paragraph) should no longer apply.

In paragraph 7 of the Office action, the Examiner rejected claims 7, 9 and 11 thru 14 under 35 U.S.C. §112 (second paragraph) for alleged indefiniteness. In response to this rejection, independent claim 7 is being amended so as to recite, in the preamble of the claim, “In a system which includes a transmitting facsimile apparatus for transmitting a facsimile message ...”. Moreover, independent claim 7 now recites that the “informing means” is “located at said first receiving facsimile machine”. Finally, dependent claims 9 and 11 thru 14 are being amended to begin with the words “In the system of ...”. As a result, the rejection of claims 7, 9 and 11 thru 14 under 35 U.S.C. §112 (second paragraph) for alleged indefiniteness should no longer apply.

On page 5 of the Office action, the Examiner rejected claims 1, 3, 6, 7, 9, 11 and 14 under 35 U.S.C. §103 for alleged unpatentability over Heo *et al.*, U.S. Patent No. 5,825,990 in view of Ranalli *et al.*, U.S. Patent No. 6,747,761. On page 10 of the Office action, the Examiner rejected claims 4 and 5 under 35 U.S.C. §103 for alleged

unpatentability over a combination of Heo *et al.* '990 and Ranalli *et al.* '761, and further in view of Hwang *et al.*, U.S. Patent No. 5,822,084. For the reasons stated below, it is submitted that the invention recited in the claims, as now amended, is distinguishable from the prior art cited by the Examiner so as to preclude rejection under 35 U.S.C. §103.

On page 6 of the Office action, the Examiner admits that Heo *et al.* '990 does not expressly teach that a telephone number of a second receiving facsimile machine is sent to a transmitting facsimile machine from the first receiving facsimile machine for the purpose of alternate facsimile data transmission and reception. However, the Examiner cites Ranalli *et al.* '761 as allegedly teaching the method of sending a telephone number of a second/alternate receiving facsimile machine to a transmitting facsimile machine when a first receiving facsimile machine cannot receive faxed data due to an error occurrence, the Examiner citing column 2, lines 30-32 and column 5, lines 10-21 of Ranalli *et al.* '761. Applicant respectfully disagrees with the rejection for the following reasons.

Ranalli *et al.* '761 concerns the delivery of facsimile documents over a value added network "such as a store-and-forward network" (*see* column 1, lines 5-7 of Ranalli *et al.* '761). As further disclosed in the cited patent, the transport of information from a source facsimile machine to a destination facsimile machine using the store-and-forward (S & F) network requires three distinct steps: (1) transmission from the source facsimile

machine to the source network node via a public switched telephone network (PSTN); (2) transmission from the source node to the destination node via a dedicated circuit; and (3) transmission from the destination node to the destination facsimile machine, again via the PSTN (*see* column 1, lines 45-54 of Ranalli *et al.* '761).

As further disclosed in Ranalli *et al.* '761, after a source node receives an incoming facsimile document, it prepares the document for transmission to a destination node (*see* column 2, lines 7-17 of Ranalli *et al.* '761). Upon concluding a delivery attempt process, the destination network node declares the facsimile document either "delivered" or "not delivered", as the case may be (*see* column 2, lines 18-20 of Ranalli *et al.* '761). Furthermore, if the delivery was not successful, the document is forwarded to a delivery assist system (DAS) for further processing, the DAS having a database management system which provides a human operator, a document delivery analyst, with the delivery history and options for resubmission to the network of a document in question (*see* column 2, lines 22-30 of Ranalli *et al.* '761).

Finally, the patent states that one of the possible options that the analyst may take is to assign the facsimile document to an alternate destination number, *i.e.*, one provided by either the sender or the receiver (*see* column 2, lines 30-33 of Ranalli *et al.* '761). The latter citation comes from the first portion of Ranalli *et al.* '761 cited by the Examiner, that is, column 2, lines 30-33 of the patent.

Referring to the second portion of Ranalli *et al.* '761 cited by the Examiner, that is, column 5, lines 10-21 thereof, the patent discloses (with reference to Figure 2) a lower block 74 designated "delivery communication" which apparently includes requests sent to the source or destination for additional delivery information, and the response thereto (*see* column 5, lines 10-12 of Ranalli *et al.* '761). It is further stated that, for example, a source (or customer) may be contacted via facsimile with a request to provide an alternative number for the destination of a non-delivered document, and that the rule-based process may initiate the generation of such a request when certain conditions are met during traversal of the rule-based decision tree (*see* column 5, lines 13-18 of Ranalli *et al.* '761).

Thus, a first distinction between the present invention and the disclosure of Ranalli *et al.* '761 resides in the fact that, according to the invention, as a first step of a subprocess in a process of transmitting a facsimile message from a transmitting facsimile machine to a first receiving facsimile machine, a telephone number of a second receiving facsimile machine to be used in the event that an error occurs in the transmission is inputted. This is in contrast to the disclosure of Ranalli *et al.* '761, which (as discussed above) concerns a more involved, manual system for providing an alternate receiving facsimile machine to be used in the event that an error occurs. That is, according to Ranalli *et al.* '761, a request for an alternative number for the destination is generated when certain conditions are met. Therefore, if Heo *et al.* '990 were modified by the

disclosure of Ranalli *et al.* '761 as suggested by the Examiner, the Heo *et al.* '990 arrangement or method would only be provided with a more involved, manual system for providing the telephone number of an alternate receiving facsimile machine.

A second distinction between the invention and the prior art resides in the fact that, whereas both the present invention and Heo *et al.* '990 relate to a process for transmitting a facsimile message directly from a transmitting facsimile machine to a receiving facsimile machine, in contrast, Ranalli *et al.* '761 concerns the transmission of a document from a first machine to a second machine via a store-and-forward (S & F) system. This results in two problems with respect to the present rejection.

First, it raises a question as to the propriety of combining the disclosure of Heo *et al.* '990 with that of Ranalli *et al.* '761 since Heo *et al.* '990 concerns a direct facsimile transmission system between first and second facsimile machines, whereas the Ranalli *et al.* '761 concerns the indirect transmission of facsimile documents between first and second facsimile machines via an S & F system.

Second, the combination of the two references will result in modification of the disclosure of Heo *et al.* '990 so as to convert the system and method of Heo *et al.* '990 into an S & F system in accordance with the disclosure of Ranalli *et al.* '761. Thus, the resultant system and method will not correspond to the direct transmission method and

system disclosed and claimed in the present application.

Finally, the fact that Heo *et al.* '990 concerns a direct facsimile transmission system whereas Ranalli *et al.* '761 relates to an indirect transmission system raises a question as to whether one of ordinary skill in the art, upon reviewing Heo *et al.* '990, would be motivated to seek the disclosure of the S & F system of Ranalli *et al.* '761 in order to modify the disclosure of Heo *et al.* '990 in an effort to obtain the present invention. Thus, the combination of references cited under 35 U.S.C. §103 constitutes an improper combination of references under the statute.

Turning to consideration of the rejection of claim 7 based on the same combination of references, as set forth in paragraph 12 of the Office action, the same arguments set forth above relative to independent claim 1 apply also to independent claim 7. The same is true of the rejection of dependent claim 9, as set forth in paragraph 13 of the Office action.

Turning to consideration of the rejection of dependent claim 4 under 35 U.S.C. §103 based on the combination of Heo *et al.* '990 and Ranalli *et al.* '761, and further in view of Hwang *et al.* '084, as set forth in paragraph 16 of the Office action, the Examiner admits that Heo *et al.* '990 in combination with Ranalli *et al.* '761 does not expressly teach the step of converting error information into bitmap data when the telephone

number of the transmitting facsimile machine is detected and the communication line is formed. However, the Examiner cites Hwang *et al.* '084 as allegedly teaching a method of sending back an error message to a transmitter and printing the error message at the transmitter (citing column 1, lines 48-53 and column 4, lines 13-24 of Hwang *et al.* '084).

However, a review of the cited passages of Hwang *et al.* '084 reveals that Hwang *et al.* '084 discloses that, when transmitting a plurality of documents, if a document transmission is interrupted by a paper jam or line error, the facsimile machine uses a warning display lamp in order to warn the users of the transmission error, or selectively prints a message transmission confirmation report informing the users of the generated status thereof (*see* column 1, lines 48-54 of Hwang *et al.* '084).

Furthermore, Hwang *et al.* '084 discloses that the display 35 of an operating panel (OPE) 30 also performs a display function by inputting display data representative of the operational status of the facsimile machine (*see* column 3, lines 9-12 of Hwang *et al.* '084). Finally, Hwang *et al.* '084 discloses that a warning display lamp located in the OPE 30 for the purpose of warning the users of the transmission error is used by the facsimile machine, or that a message transmission confirmation report is selectively printed informing the users of the generated status of the machine (*see* column 4, lines 15-18 of Hwang *et al.* '084).

Thus, Hwang *et al.* '084 clearly concerns the provision of some form of error indicator (either via display lamp or a printed message) at the receiving facsimile machine itself, and not the transmission of any error message to a sending facsimile machine for the purpose of warning the local user or operator of the sending machine of the error. Thus, Hwang *et al.* '084 is not properly combinable with either of the two previously cited references since it is strictly limited to the situation of providing a local indication of an error to the users of the receiving facsimile machine which experiences the error.

Furthermore, the Examiner cited Hwang *et al.* '084 against claim 4, which recites the step of converting error information into bitmap data when a telephone number of a transmitting facsimile machine is detected and a communication line with a transmitting facsimile machine is formed. However, at no point in the disclosure of Hwang *et al.* '084, or in the passages cited by the Examiner, is there any mention whatsoever of the conversion of an error information into bitmap data. Thus, even if Hwang *et al.* '084 were properly combinable with Heo *et al.* '990 and Ranalli *et al.* '761, the resultant arrangement or method would not contain the step of converting error information into bitmap data as recited in claim 4.

Finally, new dependent claims 15 and 16 provide further bases for distinguishing the invention over the prior art in that none of the references, either alone or in

combination, discloses or suggests the step or function of automatically inputting the telephone number of a second receiving facsimile machine to be used when an error occurs at the first receiving facsimile machine.

In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

No fee is incurred by this Amendment.

Respectfully submitted,



Robert E. Bushnell,
Attorney for the Applicant
Registration No.: 27,774

1522 "K" Street N.W., Suite 300
Washington, D.C. 20005
(202) 408-9040

Folio: P56063
Date: 8/1/05
I.D.: REB/JGS